IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TTAB

AMERICAN ITALIAN PASTA COMPANY, Opposer, v. BARILLA G. E R. FRATELLI – SOCIETA PER AZIONI, Applicant.	Opposition No. 91161373

APPLICANT'S TRIAL BRIEF

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SOCIETA PER AZIONI

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Applicant, Barilla G. E R. Fratelli – Societa per Azioni ("Barilla") hereby submits its trial brief in connection with Opposition No. 91161373 against Opposer, American Italian Pasta Company ("AIPC").

INTRODUCTION

This case hinges on whether or not AIPC has proven that it acquired distinctiveness in the slogan AMERICA'S FAVORITE PASTA prior to June 18, 2002 when Barilla filed its intent-to-use application for BARILLA – AMERICA'S FAVORITE PASTA. If, as the record shows, AIPC failed to prove that the slogan acquired distinctiveness prior to when Barilla filed its intent-to-use application, Barilla has priority in the slogan and this opposition should be dismissed. If AIPC showed acquired distinctiveness in the slogan prior to Barilla's filing date, AIPC would have been entitled to priority, and the issue would have become whether or not likelihood of confusion existed between the marks, which the record shows did not.

AIPC bases this opposition on alleged trademark rights in slogans subject to two applications, both claiming acquired distinctiveness – AMERICA'S FAVORITE PASTA (Apn. Serial No. 76/497,489) and AMERICA'S FAVORITE PASTA and Design (Apn. Serial No. 76/497,190).

For the first slogan, AMERICA'S FAVORITE PASTA (Apn. Serial No. 76/497,489), AIPC did not prove that it made trademark use prior to June 18, 2002 when Barilla filed its intent-to-use application. However, even if the Trademark Trial and Appeal Board (the "Board") finds that AIPC did make some trademark use prior to June 2002, the evidence provided by AIPC is hardly the "compelling proof" required to find acquired distinctiveness for the "merely laudatory" AMERICA'S FAVORITE PASTA

slogan. Specifically, AIPC has shown minimal (if any) proper trademark use, no advertising expenditures, an insubstantial amount of sales during the relevant time period, no consumer affidavits, and no relevant surveys.

For the second slogan, AMERICA'S FAVORITE PASTA and Design (Apn. Serial No. 76/497,190), AIPC filed this application claiming a date of first use of May 2002. Less than one month later on June 18, 2002, Barilla filed its intent-to-use application for BARILLA – AMERICA'S FAVORITE PASTA. AIPC failed to present sufficient evidence to demonstrate that this slogan acquired distinctiveness in the one month AIPC used it prior to when Barilla filed its intent-to-use application. Therefore, AIPC's application cannot be a basis of the subject opposition because it lacked distinctiveness at the time Barilla filed its intent-to-use application.

If the Board determines that AIPC has proven that it had acquired distinctiveness in the AMERICA'S FAVORITE PASTA slogan prior to June 18, 2002 when Barilla filed its intent-to-use application, consumers cannot and will not be confused as to the source of the goods. AMERICA'S FAVORITE PASTA is a weak mark and therefore entitled to a narrow scope of protection. Therefore, the differences between the marks are sufficient to make confusion unlikely. Moreover, Barilla is in fact the leading seller of pasta in America. AIPC has failed to meet its burden of proof with respect to the existence of a likelihood of confusion.

Finally, AIPC attempts to distract the Board with allegations of Barilla's alleged lack of a bona fide intent-to-use the mark when it filed its application. AIPC has not met its burden of proof. AIPC simply points to two innocuous facts – (1) AIPC filing four intent-to-use applications on the same day for allegedly "nearly identical" marks; and (2)

a statement by a Barilla employee that Barilla filed its application to "notify consumers that contrary to Mueller's false claim, Barilla was the leading brand of pasta in terms of market share in the United States." These facts hardly prove that Barilla lacked a bona fide intent-to-use the mark.

Applicant therefore, requests that the Board deny this opposition.

DESCRIPTION OF RECORD

Barilla adopts AIPC's Description of the Record with the following additions: the Board's Ruling mailed July 11, 2006 on Applicant's Motion for Summary Judgment; the following documents made of record by way of a Notice of Reliance filed by Barilla on January 12, 2007:

Exhibit	Description
A1	Opposer's Answers to Applicant's First Requests for Admissions
A2	Opposer's Answers to Applicant's Second Requests for Admissions
A3	Opposer's Answers to Applicant's Third Set of Requests for Admissions Nos. 15 – 20
A4	Opposer's Answers to Applicant's Fourth Set of Requests for Admissions Nos. 21 – 37
A5	Opposer's Answers to Applicant's Fifth Set of Requests for Admissions Nos. 38 – 82
A6	Opposer's Supplemental Answers to Applicant's Fifth Set of Requests for Admissions Nos. 38 – 82
A7	Opposer's Answers to Applicant's First Set of Interrogatories

A8	Opposer's Answers to Applicant's Second Set of Interrogatories
A9	Opposer's Answers to Applicant's Third Set of Interrogatories
A10	Opposer's Answers to Applicant's Fourth Set of Interrogatories
A11	Opposer's Confidential Attorneys' Eyes Only Supplemental Answers to Applicant's Fourth Set of Interrogatories (FILED UNDER SEAL)

STATEMENT OF ISSUES

1. Did AIPC meet its burden of proof in demonstrating that the AMERICA'S FAVORITE PASTA slogan acquired distinctiveness prior to June 18, 2002 when Barilla filed its intent-to-use application?

2. Did AIPC meet its burden of proof in demonstrating that the AMERICA'S FAVORITE PASTA and DESIGN slogan acquired distinctiveness in the one month AIPC used the mark prior to June 18, 2002 when Barilla filed its intent-to-use application?

3. Did AIPC meet its burden of proof in demonstrating that Barilla did not have a bona fide intent-to-use the BARILLA – AMERICA'S FAVORITE PASTA mark when Barilla filed its application?

4. Did AIPC meet its burden of proof in demonstrating that there is a likelihood of confusion between the marks?

RECITATION OF FACTS

Barilla's Applications

1. In 1998 Barilla became the number one national brand in dry pasta sales in the United States and still is today. *See* Pereira Dep., p. 18, ls. 22-23 and p. 11, ls. 17-21.

2. In the summer of 2002, Barilla concluded that the slogan BARILLA – AMERICA'S FAVORITE PASTA truthfully and accurately described Barilla's stature as the number one ranking of this brand in terms of consumer sales and consumption. *See* Pereira Dep., p. 15, ls. 1-4. Mr. Pereira, Vice President of marketing for Barilla America, Inc. testified that he was involved in identifying the marks four marks that Barilla wanted to apply for on an intent-to-use basis when BARILLA became the number one brand in sales in the United States. *See* Pereira Dep., p. 9, ls. 20-24 and p. 10, ls. 1-3.

3. On June 18, 2002, Barilla filed its intent-to-use trademark application for BARILLA – AMERICA'S FAVORITE PASTA (Ser. No. 78/136,703) for "pasta, pasta products, namely meals consisting primarily of pasta, macaroni salad, pasta salad, sauces for pasta." *See* Pereira Dep., Exh. 2.

4. Barilla's filed its BARILLA – AMERICA'S FAVORITE PASTA application (Ser. No. 78/136,703) based on an intent "to essentially denote the fact that the product is and was at the time the highest sales brand in the United States." *See* Pereira Dep., p. 10, ls. 13-16.

5. During the prosecution of its BARILLA – AMERICA'S FAVORITE PASTA application (Ser. No. 78/136,703), Barilla disclaimed "AMERICA'S FAVORITE PASTA" because the Examining Attorney found the wording descriptive. *See* Pereira Dep., Exh. 2.

6. On June 18, 2002, Barilla also filed the following intent-to-use trademark applications: BARILLA – AMERICA'S PREFERRED PASTA (Ser. No. 78/136,708), BARILLA – AMERICA'S #1 PASTA (Apn. No. 78/136,706); and BARILLA – AMERICA'S BEST PASTA (Apn. No. 78/136,701), all for "pasta, pasta products, namely meals consisting primarily of pasta, macaroni salad, pasta salad, sauces for pasta." *See* Pereira dep., Exh. 5, 6.

7. On November 25, 2004, Barilla permitted its application for BARILLA – AMERICA'S BEST PASTA (Apn. No. 78/136,701) to lapse. *See* Pereira Dep., p. 22, ls. 1-8.

8. Barilla filed its BARILLA – AMERICA'S #1 PASTA mark (Apn. No. 78/136,706) to "denote that the brand was, in fact, the number one pasta brand in sales in the United States for consumption." *See* Pereira Dep., p. 14, ls. 3-6.

9. Barilla also uses the slogan ITALY'S #1 PASTA. *See* Pereira Dep., Opposer's Exh. 115.

AIPC'S Application for AMERICA'S FAVORITE PASTA

10. AIPC filed a trademark application for AMERICA'S FAVORITE PASTA (Apn. No. 76/497,489) on March 14, 2003 for "pasta." AIPC filed its application claiming that the mark had acquired distinctiveness under Section 2(f) of the Lanham Act and alleged a date of first use of September 1997. *See* Lericos Dep., Exh. 85.

11. AIPC also filed a trademark application for AMERICA'S FAVORITE PASTA & Flag Design (Apn. No. 76/497,190) on March 14, 2003 for "pasta." AIPC filed its application claiming that the word portion, AMERICA'S FAVORITE PASTA, had

acquired distinctiveness under Section 2(f) of the Lanham Act and alleged a date of first use of May 2002. *See* Lericos Dep., p. 85, ls. 3-4; Exh. 86.

12. The examining attorney has not passed AIPC's Application Nos. 76/497,489 and 76/497,190 to publication but has stated that he has searched the Office records and has found no similar *registered* mark which would bar registration under Lanham Act Section 2(d), 15 U.S.C. Section 1052(d). *See* Lericos Dep., Exh. 85, 86.

13. At AIPC's request, the examining attorney suspended both applications. *Id.*

14. AIPC discontinued use of its AMERICA'S FAVORITE PASTA & Flag Design mark (Apn. No. 76/497,190) on packaging in December 2005. *See* Lericos Dep., p. 95, ls. 17-20 and p. 96, ls. 18-21; *See* Webster Dep., p. 64, ls. 19-22.

AIPC'S Alleged Use of its AMERICA'S FAVORITE PASTA slogan

15. AIPC promotes its MUELLER'S brand primarily in the eastern half of the United States, which it calls "Muellerland." *See* Webster Dep., p. 54, l. 4.

16. AIPC began using the slogan AMERICA'S FAVORITE PASTA to convey to the consumer that Mueller's pasta products were "American-made pasta for the way Americans enjoy pasta. So it's very much an Americana positioning." *See* Lericos Dep., p. 60, ls. 11-18.

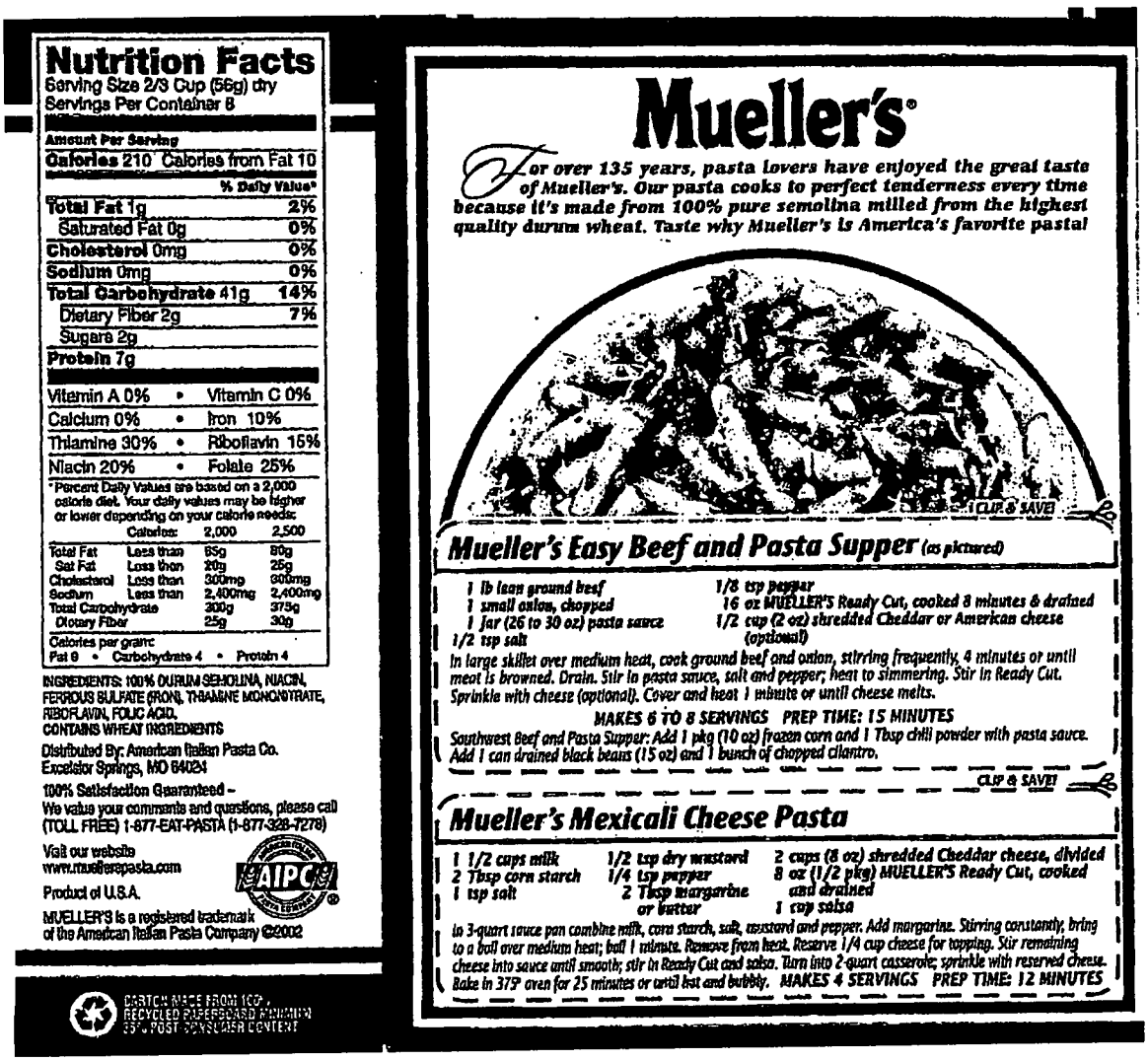
17. AIPC admits that the slogan AMERICA'S FAVORITE PASTA "does not refer to any brand or any factual attribute of the product, its merely descriptive of the essence that it's an American pasta brand that Americans are fond of." *See* Lericos Dep., p. 63, ls. 5-14.

18. From 1997 through December of 2005, AIPC and its predecessor, only used the descriptive slogan, AMERICA'S FAVORITE PASTA, in close proximity to its

MUELLER'S house mark. See Opposer's Exh. 86, SN 76/497190 specimen of use; Opposer's Answer to Applicant's Admission Request No. 3. AIPC has never promoted AMERICA'S FAVORITE PASTA without reference to the MUELLER'S brand of pasta products. *Id.*

19. The brand identity for the MUELLER'S brand has been on packaging since 1914. *See* Willoughby Dep., p. 85, ls. 4-11.

20. "Taste why Mueller's® is America's favorite pasta!" has appeared on MUELLER'S packaging from 1997 to December 2005 in the paragraph on the back of the packaging:



Nutrition Facts
Serving Size 2/3 Cup (56g) dry
Servings Per Container 8

Amount Per Serving	
Calories 210	Calories from Fat 10
	% Daily Value*
Total Fat 1g	2%
Saturated Fat 0g	0%
Cholesterol 0mg	0%
Sodium 0mg	0%
Total Carbohydrate 41g	14%
Dietary Fiber 2g	7%
Sugars 2g	
Protein 7g	

Vitamin A 0%	•	Vitamin C 0%	
Calcium 0%	•	Iron 10%	
Thiamine 30%	•	Riboflavin 15%	
Niacin 20%	•	Folate 25%	

*Percent Daily Values are based on a 2,000 calorie diet. Your daily values may be higher or lower depending on your calorie needs:

	Calories:	2,000	2,500
Total Fat	Less than	65g	80g
Sat Fat	Less than	20g	25g
Cholesterol	Less than	300mg	300mg
Sodium	Less than	2,400mg	2,400mg
Total Carbohydrate		300g	375g
Dietary Fiber		25g	30g

Calories per gram:
Fat 9 • Carbohydrate 4 • Protein 4

INGREDIENTS: 100% DURUM SEMOLINA, NIACIN, FERROUS SULFATE (IRON), THIAMINE MONONITRATE, RIBOFLAVIN, FOLIC ACID.
CONTAINS WHEAT INGREDIENTS

Distributed By: American Italian Pasta Co.
Excelsior Springs, MO 64024

100% Satisfaction Guaranteed –
We value your comments and questions, please call (TOLL FREE) 1-877-EAT-PASTA (1-877-328-7278)

Visit our website
www.muellerspasta.com

Product of U.S.A.

MUELLER'S is a registered trademark of the American Italian Pasta Company ©2002

AIPC

BATCH MADE FROM 100% RECYCLED PAPERBOARD MINIMUM 35% POST CONSUMER CONTENT

Mueller's®

For over 135 years, pasta lovers have enjoyed the great taste of Mueller's. Our pasta cooks to perfect tenderness every time because it's made from 100% pure semolina milled from the highest quality durum wheat. Taste why Mueller's is America's favorite pasta!

CLIP & SAVE!

Mueller's Easy Beef and Pasta Supper (as pictured)

1 lb lean ground beef
1 small onion, chopped
1 jar (26 to 30 oz) pasta sauce
1/2 tsp salt
1/8 tsp pepper
16 oz MUELLER'S Ready Cut, cooked 8 minutes & drained
1/2 cup (2 oz) shredded Cheddar or American cheese (optional)

In large skillet over medium heat, cook ground beef and onion, stirring frequently, 4 minutes or until meat is browned. Drain. Stir in pasta sauce, salt and pepper; heat to simmering. Stir in Ready Cut. Sprinkle with cheese (optional). Cover and heat 1 minute or until cheese melts.

MAKES 6 TO 8 SERVINGS PREP TIME: 15 MINUTES

Southwest Beef and Pasta Supper: Add 1 pkg (10 oz) frozen corn and 1 Tbsp chili powder with pasta sauce. Add 1 can drained black beans (15 oz) and 1 bunch of chopped cilantro.

CLIP & SAVE!

Mueller's Mexicali Cheese Pasta

1 1/2 cups milk
2 Tbsp corn starch
1 tsp salt
1/2 tsp dry mustard
1/4 tsp pepper
2 Tbsp margarine or butter
2 cups (8 oz) shredded Cheddar cheese, divided
8 oz (1/2 pkg) MUELLER'S Ready Cut, cooked and drained
1 cup salsa

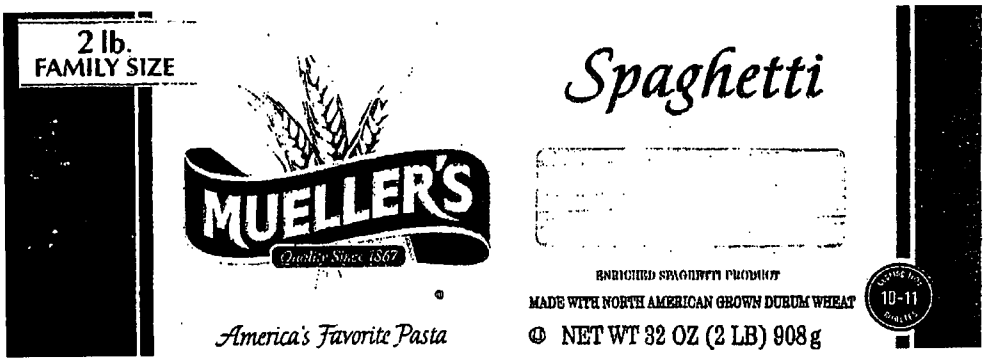
In 3-quart sauce pan combine milk, corn starch, salt, mustard and pepper. Add margarine. Stirring constantly, bring to a boil over medium heat; boil 1 minute. Remove from heat. Reserve 1/4 cup cheese for topping. Stir remaining cheese into sauce until smooth; stir in Ready Cut and salsa. Turn into 2-quart casserole; sprinkle with reserved cheese. Bake in 375° oven for 25 minutes or until hot and bubbly. MAKES 4 SERVINGS PREP TIME: 12 MINUTES

See Lericos Dep., p. 96, ls. 8 – 10; Exh. 17.

21. Mr. Webster, former President and Chief Executive Officer of AIPC, admitted that the descriptive slogan AMERICA'S FAVORITE PASTA was linked on the packaging to Mueller's brand name and medallion. *See* Webster Dep., p. 69, ls. 9 -13.

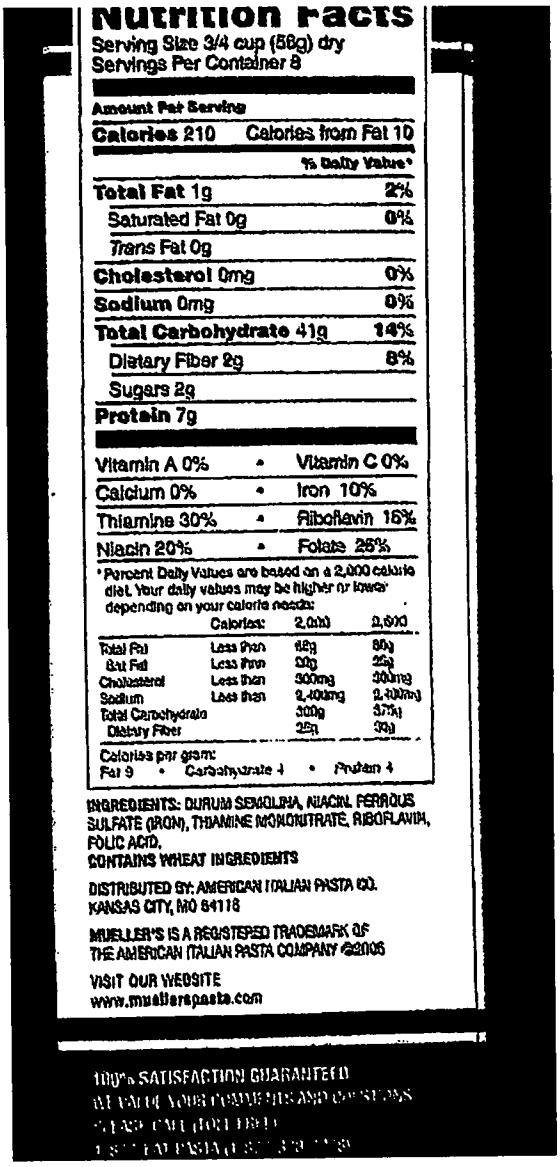
22. Mr. Lericos, Vice President of Marketing for AIPC, admitted that no survey or any retailer ever told him that a consumer asked for AMERICA'S FAVORITE PASTA. *See* Lericos Dep., p. 103, ls. 16-19.

23. Since November 2000, AIPC has placed the phrase AMERICA'S FAVORITE PASTA on its original Mueller's packaging along with other phrases such as QUALITY SINCE 1867 or MADE WITH NORTH AMERICAN GROWN DURUM WHEAT. *See* Lericos Dep., Exh. 2.



24. Since November 2000, AIPC's packaging for Mueller's pasta products has always contained the following statement on the side of the packaging: "Mueller's is a registered

trademark of the American Italian Pasta Company" followed by a copyright claim.



Nutrition Facts
Serving Size 3/4 cup (56g) dry
Servings Per Container 8

Amount Per Serving

Calories 210	Calories from Fat 10
	% Daily Value*
Total Fat 1g	2%
Saturated Fat 0g	0%
Trans Fat 0g	
Cholesterol 0mg	0%
Sodium 0mg	0%
Total Carbohydrate 41g	14%
Dietary Fiber 2g	8%
Sugars 2g	
Protein 7g	

Vitamin A 0%	•	Vitamin C 0%	
Calcium 0%	•	Iron 10%	
Thiamine 30%	•	Riboflavin 15%	
Niacin 20%	•	Folate 25%	

* Percent Daily Values are based on a 2,000 calorie diet. Your daily values may be higher or lower depending on your calorie needs:

	Calories:	2,000	2,500
Total Fat	Less than	65g	80g
Sat Fat	Less than	20g	25g
Cholesterol	Less than	300mg	300mg
Sodium	Less than	2,400mg	2,400mg
Total Carbohydrate		300g	375g
Dietary Fiber		25g	30g

Calories per gram:
Fat 9 • Carbohydrate 4 • Protein 4

INGREDIENTS: DURUM SEMOLINA, NIACIN, FERROUS SULFATE (IRON), THIAMINE MONONITRATE, RIBOFLAVIN, FOLIC ACID.
CONTAINS WHEAT INGREDIENTS

DISTRIBUTED BY: AMERICAN ITALIAN PASTA CO.
KANSAS CITY, MO 64116

MUELLER'S IS A REGISTERED TRADEMARK OF THE AMERICAN ITALIAN PASTA COMPANY ©2006

VISIT OUR WEBSITE
www.muellerspasta.com

100% SATISFACTION GUARANTEED

See Germain Dep., Exh. 15.

25. As shown above, on various packages, the phrases "Quality Since 1867," "Made from 100% Semolina," or "Made with Semolina" accompany the slogan "America's Favorite Pasta." See Lericos Dep., p. 36, ls. 9-16; Exh. 57.

26. AIPC has never published a single advertisement promoting AMERICA'S FAVORITE PASTA separate and apart from the MUELLER'S brand. See Lericos Dep., p. 91, ls. 1-22 and p. 103, ls. 8-15.

27. In 2002, AIPC conducted a consumer research study entitled "Mueller's Pasta Quantitative Research Results, Positioning Recommendation & Re-launch Action Plan of 2002." *See* Lericos Dep., p. 75, ls. 20-25. This survey only looks forward in time and does not show that consumer's recognize AMERICA'S FAVORITE PASTA as an indication of source for MUELLER pasta. *See* Lericos Dep., p. 65, ls. 14-17; Exh. 77.

28. AIPC had a market research report entitled "Long Version" (AIPC Exhibit 75), which only looks to the future and does not address how consumers perceive the slogan. *See* Lericos Dep., p. 63, ls. 20-25; Exh. 75.

29. AIPC had a market research report entitled "Short Version", which descriptively refers to the slogan AMERICA'S FAVORITE PASTA only once on page A05949 under Trust/Heritage, as part of [MUELLER'S] brand essence and does not prove that consumer's recognize the slogan as an indication of origin. *See* Lericos Dep., p. 64, ls. 4-8; Exh. 76.

30. In March 2004, AIPC conducted another consumer research study comparing the AIPC brands (MUELLER'S (north), MUELLER's (south), GOLDEN GRAIN, MARTHA GOUCH, R&F, ANTHONY'S, RONCO and LUXURY) and "Barilla (the only national brand of pasta) and New World Pasta, and private label brands." *See* Lericos Dep., Exh. 79, p. A011286. Mr. Lericos' testified about this survey. *See* Lericos Dep., p. 74, ls. 6-25, p. 75, ls. 1, 18, 22.

31. In December 2005, AIPC changed its packaging to use the descriptive slogan AMERICA'S FAVORITE PASTA separately as a brand. *See* Lericos Dep., p. 12, ls. 2-5; Exh. 3.

32. AIPC has never used the slogan AMERICA'S FAVORITE PASTA with the trademark symbol, TM, to provide notice to the public that it is being used as a trademark. *See* Lericos Dep., p. 102, ls. 13-24.

33. AIPC understands the importance of using the TM designation on descriptive marks, as it did on MICRO QUICK [Opp. Exh. 47], See Webster Dep., P. 18, ls. 23-25, p. 19, ls. 1-5 .

34. AIPC itself uses AMERICA'S FAVORITE NOODLE as advertising for its noodles. See Webster Dep., p. 35, ls. 19-21.

35. AIPC's figures demonstrate pasta volume in pounds and sales from the years 2000-2005. *See* Lericos Dep., p. 77, ls. 18-25 and p. 78, ls. 1-8.

36. AIPC's exhibits 0117 through 0214 show many uses of AMERICA'S FAVORITE on foods, pizza, pizza crust, etc. *See* Opposer's Notice of Reliance, Exh. 117-214.

37. As for use of the slogan AMERICA'S FAVORITE PASTA, there are third-party uses – *e.g.* a spaghetti cook book by Joie Warner with the descriptive slogan AMERICA'S FAVORITE PASTA on the cover. *See* Lericos Dep., p. 103, 1.20 through p. 104, 1.4,; Exh. 87.

AIPC's Purchase of the Mueller's Brand

38. In November 2000, AIPC purchased Mueller's business from BestFoods and the document evidencing the assignment of properties from BestFoods to AIPC lists the patents, trademarks (both national and foreign) and copyrights contemplated as part of the purchase. *See* Germain Dep., p. 48, l. 3; Lericos Dep. p. 11, ls. 19-20.

39. The assignment document of the BestFoods' pasta business in 2000 included over two dozen trademarks but did not include an AMERICA'S FAVORITE PASTA as one of the purchased trademarks. *See* Opposer's Exh. 102; Germain Dep., p. 49, ls. 1-18.

The Current Opposition

40. In its Notice of Opposition, AIPC opposed Barilla's application for the trademark, BARILLA – AMERICA'S FAVORITE PASTA (Apn. No. 78/136,703), based on, *inter alia*, a likelihood of confusion with two subsequently filed applications – AMERICA'S FAVORITE PASTA (Apn. No. 76/497,489) and AMERICA'S FAVORITE PASTA & Flag Design (Apn. No. 76/497,190). *See* Opposer's Notice of Opposition, p. 3.

41. In its Answer to the Notice of Opposition, Barilla denied the allegations that AIPC's marks have acquired distinctiveness and that there is a likelihood of confusion between Barilla's BARILLA – AMERICA'S FAVORITE PASTA mark and AIPC's AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA & Design marks. *See* Appliants Answer to Opposer's notice of Opposition, p. 2.

42. The Trademark Trial and Appeal Board ("TTAB") ruled in summary judgment that AMERICA'S FAVORITE PASTA is descriptive. *See* TTAB's Summary Judgment Decision dated July 11, 2006 ("SJ Decision"), p.5.

ARGUMENTS

I. AIPC'S AMERICA'S FAVORITE PASTA MARK DID NOT ACQUIRE DISTINCTIVENESS PRIOR TO JUNE 18, 2002 WHEN BARILLA FILED ITS INTENT-TO-USE APPLICATION, AND THEREFORE, BARILLA HAS PRIORITY

AIPC filed a trademark application for AMERICA'S FAVORITE PASTA (Ser. No. 76/497,489) on March 14, 2003 for "pasta" claiming that the mark has acquired distinctiveness under Section 2(f) and alleging a date of first use of September 1997. *See*

Lericos Dep., Exh. 85. However, AIPC's claim of acquired distinctiveness under Section 2(f) for its AMERICA'S FAVORITE PASTA slogan is not supported by the record. As detailed below, the record shows that AIPC's descriptive slogan was first used as a trademark after June 18, 2002 (the date Barilla filed its intent-to-use application). Since AIPC's claim of distinctiveness fails, its priority date is the filing date of the AMERICA'S FAVORITE PASTA application namely, March 14, 2003 – nine months after Barilla's June 18, 2002 filing date for its intent-to-use application.

The TTAB ruled in summary judgment that AIPC's use of the AMERICA'S FAVORITE PASTA slogan was descriptive. *See* Summary Judgment Decision, p. 5. Therefore, AIPC must prove that the slogan acquired distinctiveness prior to June 18, 2002 when Barilla filed its intent-to-use application. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 U.S.P.Q. 40, 43. (C.C.P.A. 1981) Contrary to AIPC's argument, AIPC bears the burden of proof with respect to its claim of priority of use and likelihood of confusion. *See, e.g., Bose Corp. v. QSC Audio Prod.*, 293 F.3d 1367, 63 U.S.P.Q. 2d 1303, 1305 (Fed. Cir. 2002) ("the burden of proof rests with the opposer . . . to produce sufficient evidence to support the ultimate conclusion of [priority of use and] likelihood of confusion"). AIPC erroneously argues that Barilla should have the burden to establish that AIPC's marks have not acquired distinctiveness citing *Yamaha Int'l Corp. v. Hoshino Gakki Co.,* 840 F.2d 1572 (Fed. Cir. 1988). *See* Opposer's Trial Brief ("Opposer's Br."), p. 26. However, in *Yamaha,* the applicant (Hoshino Gakki) claimed acquired distinctiveness under Section 2(f), and the examining attorney passed the application to publication where it was then opposed. *Id.*

In this case, the examining attorney has not passed AIPC's applications Serial No. 76/497,489 or Serial No. 76/497,190 to publication but has stated that he has searched the Office records and has found no similar *registered* mark which would bar registration under Lanham Act Section 2(d), 15 U.S.C. Section 1052(d). *See* Lericos Dep., Exh. 86. At AIPC's request, the examining attorney has suspended the application. *Id.* This suspension action does not relinquish the examiner's jurisdiction over the descriptive slogan. TMEP §§ 1504.01 ("Jurisdiction of Examining Attorney"). AIPC's unsupported claim of five years of continuous and exclusive use of AMERICA'S FAVORITE PASTA has not established acquired distinctiveness in the slogan sufficient to pass the application to publication under Section 2(f). Section 2(f) of the Lanham Act, permits but does not require the USPTO to accept as prima facie evidence of distinctiveness proof of "substantially exclusive and continuous use" for five years. 15 U.S.C. § 1052(f). The facts in the *Yamaha* case are distinguishable such that AIPC retains the burden of proving acquired distinctiveness.

Not only is it AIPC's burden to show that it has acquired distinctiveness in the mark prior to Barilla's filing date, the more descriptive the term, the greater the evidentiary burden on AIPC to prove acquired distinctiveness. *See American Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 182 U.S.P.Q. 77 (5th Cir.Tex. 1974). Other cases have determined the difficulty in demonstrating acquired distinctiveness for "FAVORITE" marks. Specifically, the Board rejected the marks AMERICA'S FAVORITE POPCORN! and AMERICA'S BEST POPCORN! for popcorn as being descriptive:

> When an expression consists of merely laudatory words, it is not entitled to protection as a trademark in the absence of compelling proof that is has acquired a secondary meaning to the general public.

In re Wileswood, Inc., 201 U.S.P.Q. 400 *3R (T.T.A.B. Nov. 29, 1978). AIPC has repeatedly admitted and the Eighth Circuit has confirmed that AMERICA'S FAVORITE PASTA is "merely puffery or a laudatory term." Opposer's Br., p. 17. Therefore, to be entitled to trademark protection, AIPC must demonstrate compelling proof that the merely laudatory slogan has acquired distinctiveness prior to June 18, 2002 when Barilla filed its intent-to-use application. Evidence of acquired distinctiveness can include (1) length of use of the mark, (2) advertising expenditures, (3) amount of sales, (4) survey evidence, and (5) affidavits asserting source-indicating recognition. *In re Cash Flow Solutions, Inc.*, 2006 TTAB LEXIS 355, *12 (T.T.A.B. Aug. 14, 2006). AIPC failed to prove that AMERICA'S FAVORITE PASTA acquired distinctiveness prior to Barilla filing its intent-to-use application.

A. AIPC's trademark use does not start until well after Barilla filed its intent-to-use application because use prior to 2005 was not trademark use

Evidence of acquired distinctiveness includes length of use of the mark. *In re Cash Flow Solutions, Inc.*, 2006 TTAB LEXIS 355, *12. AIPC has the burden of establishing when its rights in the mark began. *See Otto Roth*, 209 U.S.P.Q. 40 (C.C.P.A. 1981). As set forth in detail below, the record shows that before December 2005 (well after Barilla's June 18, 2002 intent-to-use filing date), AIPC:

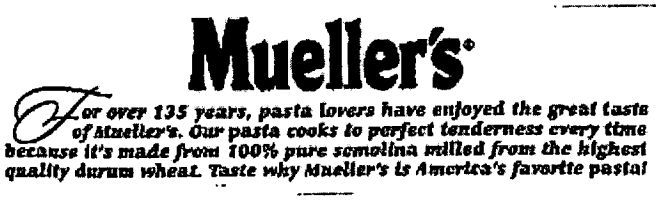
(1) continuously used the slogan AMERICA'S FAVORITE PASTA descriptively on MUELLER'S pasta packages in the sentence, "Taste why MUELLER'S® is America's favorite pasta!";

(2) continuously used the descriptive slogan AMERICA'S FAVORITE PASTA in combination with the house mark MUELLER'S® in its various renditions; and

(3) continuously failed to treat the descriptive slogan AMERICA'S FAVORITE PASTA separately as a trademark on any of its packaging or in any of its advertising.

1. Prior to Barilla filing its intent-to-use application and thereafter, AIPC continuously used the slogan AMERICA'S FAVORITE PASTA on MUELLER'S pasta packages in the sentence, "Taste why MUELLER'S® is America's favorite pasta!"

Combinations of words used as a part of an overall advertising slogan, phrase, message or the like rather than as a single unitary phrase are not registrable. *In re Morganroth*, 208 U.S.P.Q. 284, 287 (T.T.A.B. 1980) (NATUR-ALL-IZE found not registrable because its inclusion in the phrase NATUR-ALL-IZE YOUR HAIR COLORING does not serve as a trademark to identify or distinguish applicant's goods or services). "Taste why Mueller's® is America's favorite pasta!" is such an advertising slogan and appeared on AIPC's packaging from its claimed date of first use 1997 to 2005[1] in the following paragraph on the back of the packaging:



See Lericos Dep., Exh. 17, p. 11, 13 of 19; Lericos Dep., p. 96, ls. 8 – 10.

[1] Prior to 1997, the only documented reference to the "AMERICA'S FAVORITE PASTA" slogan was on a picture of packaging from the 1950's. Willoughby Dec. Exh. B. AIPC's expert also claims that AIPC used the slogan AMERICA's FAVORITE in the 1950s but stopped some unknown time thereafter. WILLOUGHBY DEPO However, as this alleged use ceased well prior to when AIPC began using the AMERICA'S FAVORITE PASTA slogan, it is irrelevant to this discussion.

AIPC's own Vice President of Marketing, Mr. Lericos, admits that AMERICA'S FAVORITE PASTA "does not refer to any brand or to any factual attribute of the product, its *merely descriptive* or the essence that it's an American pasta brand that Americans are fond of." *See* Lericos Dep., p. 63, ls. 5 – 14.[2] Moreover, Lericos further admits that AIPC began using the slogan AMERICA'S FAVORITE PASTA to convey to the consumer that Mueller's pasta products were "American-made pasta for the way Americans enjoy pasta. So it's very much an Americana positioning." *See* Lericos Dep., p. 60, ls. 11-18.

AIPC removed the "Taste why Mueller's® is America's favorite pasta!" language from the packaging in December 2005 when it repackaged the product. *See* Webster Dep., p. 64, ls. 19-22.

This clearly admitted descriptive use of AIPC's slogan is strong evidence that AIPC did not intend for the slogan to be a trademark and counters any allegation by AIPC that it acquired distinctiveness in the AMERICA'S FAVORITE PASTA slogan prior to June 18, 2002 when Barilla filed its intent-to-use application.

2. Prior to Barilla filing its intent-to-use application and thereafter, AIPC continuously used the descriptive slogan AMERICA'S FAVORITE PASTA in combination with the house mark MUELLER'S in its various renditions

When a term, slogan or word is not given a conspicuous position in marketing and is viewed by the relevant consumer as descriptive advertising, secondary meaning cannot

[2] AIPC touts that its alleged expert states that AMERICA'S FAVORITE PASTA's "sole function" is to establish brand recognition. Opposer's Br., p. 25. However, AIPC's own Vice President of Marketing admits that AMERICA'S FAVORITE PASTA does not refer to any brand. AIPC's Vice President of Marketing should know better the intent of the company than a paid litigation expert.

be established. *See Philip Morris Inc. v. R .J. Reynolds Tobacco Co.*, 188 U.S.P.Q. 289 (S.D.N.Y. 1975). In *Philip Morris*, the plaintiff claimed trademark infringement of its registered mark "Marlboro Lights" for a low tar and nicotine cigarette when competitor R.J. Reynolds introduced "Winston Lights" for a competing cigarette with the same characteristics. *Id.* Philip Morris claimed that the use of "Winston Lights" was likely to cause confusion or mistake among consumers by misattribution of the source of the cigarettes. *Id.* The District Court held that Philip Morris' use of "Lights" next to the mark "Marlboro" did not take on trademark characteristics because it was not used conspicuously and did not give prominence to the mark "Lights." *Id.*

The present facts are similar to the facts in the *Philip Morris* case. AIPC's slogan AMERICA'S FAVORITE PASTA is admittedly descriptive, and it was always used in close proximity with the house mark MUELLER'S. While products can bear more than one mark, it must be used in such a manner so as to make the brand known to consumers and to have consumers associate the brand with the product. Proctor & Gamble Co. v. Keystone Automotive Warehouse, Inc., 191 U.S.P.Q. 468, 474 (T.T.A.B. 1976). However, as demonstrated in other portions of this brief, AIPC has been unsuccessful in having consumers associate the slogan with the product. Consumers simply do not attribute the descriptive slogan as an indication of source.

In fact, AIPC admitted that the slogan was linked on the packaging with the Mueller's brand name and medallion. *See* Webster Dep., p. 69, ls. 9 -13.

The record until December 2005 shows AIPC's use of AMERICA'S FAVORITE PASTA in combination with the house mark MUELLER'S. *See* Lericos Dep., p. 101, ls.

11-18. The MUELLER'S brand has dominated AIPC's packaging since 1914. *See* Willoughby Dep., p. 86, ls. 5-8; Willoughby Dec., Exh. B.

Moreover, unless a seller takes some step to emphasize and set apart a word, phrase or picture, chances are that viewers will see it as just another bit of merchandising embellishment, or advertising message and not as an indication of source, origin, or sponsorship. See also, In re Royal Viking Line A/S, 216 USPQ 795 (TTAB 1982) ("We agree with the examining attorney that the words (WORLD CLASS) in applicant's brochure are not used as a service mark. In most instances, the term is used in a laudatory sense describing the superior qualities of applicant's ships and is not used in a manner to indicate origin of any particular service with Applicant"). Moreover, in *In re Remington*, the Board affirmed refusal to register the term PROUDLY MADE IN USA (MADE IN USA disclaimed) for electric shavers under Section 2(f). The Board held that the term did not function as a trademark within the meaning of Section 45 of the Lanham Act and, therefore, was unregistrable under Sections 1 and 2 since it was an unimaginative embellishment of a common informational phrase MADE IN USA. While Remington may have had substantial sales and advertising of its product (it sold one hundred twenty million dollars worth of shavers and spent four hundred fifty thousand dollars in advertising the product in magazines and on television) that does not prove recognition by the public of the subject slogan as a trademark. There was nothing in the record to indicate that purchasers recognized the slogan as a source indicator. *See In re Remington Prod., Inc.* 1987 TTAB LEXIS 91; 3 U.S.P.Q.2D (BNA) 1714.

As the Board has previously held, this is especially true of slogans that are descriptive or convey an advertising or promotional message:

> ...the phrase "THINK ABOUT IT" is a familiar expression, and we believe that the ordinary customer or prospective customer reading applicant's advertisement would take the phrase at its ordinary meaning rather than attributing thereto the special meaning of a service mark used to distinguish applicant's banking services from the banking services of others. In this regard, we particularly note, as did the Examiner, applicant's use of the phrase "THINK ABOUT THIS:" at the top of the ad and the phrase "THINK ABOUT IT" as part of the regular text of applicant's ad. These usages simply serve to reinforce the ordinary meaning of the phrase "THINK ABOUT IT". Accordingly, we are in full agreement with the Examiner's conclusion that the slogan "THINK ABOUT IT" as used by applicant, does not function as a service mark to identify applicant's services and distinguish them from the like services of others.

See In re European-American Bank & Trust Co., 201 U.S.P.Q. 788, 790 (T.T.A.B. 1979).

AMERICA'S FAVORITE PASTA is and has always been advertising usage and not trademark usage. The difference between advertising usage and trademark usage is that advertising usage focuses on characteristics or at least claimed characteristics of the product while trademark usage identifies the source and distinguishes that source from other sources of similar products. *See* Germain Dep., p. 14, ls. 8-10, 14-17.

AIPC has done nothing with its usage of the descriptive slogan AMERICA'S FAVORITE PASTA next to the Mueller's brand to change consumers ordinary meaning of the phrase AMERICA'S FAVORITE PASTA. If anything, AIPC has enforced this conclusion.

3. AIPC has continuously failed to treat the descriptive slogan AMERICA'S FAVORITE PASTA separately as a trademark on any of its packaging or in any of its advertising because it has never considered it to be a trademark until after Barilla filed its intent-to-use application

AIPC did not consider the AMERICA'S FAVORITE PASTA slogan to be a trademark until after Barilla filed its intent-to-use application. Specifically, AIPC:

• was not assigned any good will associated with AMERICA'S FAVORITE PASTA when AIPC purchased Mueller's business as the assignment document of Mueller's business lists over two dozen marks but did not identify AMERICA'S FAVORITE PASTA. *See* Germain Dep., Exh. 20.

• never ran a single advertisement promoting AMERICA'S FAVORITE PASTA separate and apart from the MUELLER'S brand. *See* Lericos Dep., p. ls. 1-22, p. 103, ls. 8-15; Opposer's Answer to Applicants Admission Request No. 3.

• never included AMERICA'S FAVORITE PASTA in the claim of ownership on the side panel of the packaging. After November 2000, AIPC continued to claim ownership of the house mark MUELLER's on the side panel of the packaging with the statement, "MUELLER'S IS A REGISTERED TRADEMARK OF THE AMERICAN ITALIAN PASTA COMPANY;" *see* Germain Dep. Exh. 15 at 30.

• never used the letters TM with the descriptive slogan AMERICA'S FAVORITE PASTA. *See* Lericos Dep., p. 94, ls. 8-9 and p. 102 ls. 13-24; Webster Dep., p. 67 l. 17. AIPC understands the importance of using the TM designation on descriptive marks, because it used the TM designation on its MICRO QUICK mark. *See* Webster Dep., p. 66, ls. 1-5; Exh. 47.

While, not treating one's slogan like a trademark may not in itself demonstrate that AIPC did not use the AMERICA'S FAVORITE PASTA slogan as a trademark, this fact in combination with the above-described descriptive uses of the slogan, and the continuous use of the slogan in combination with the Mueller's house mark show that AIPC never intended this slogan to be an indication of source for its pasta products until after Barilla filed its intent-to-use application. Therefore, based on the record, AIPC has

not demonstrated substantial trademark use of the AMERICA'S FAVORITE PASTA slogan prior to Barilla filed its intent-to-use application.

B. AIPC did not prove that it had any advertising expenditures or a substantial amount of sales under the AMERICA'S FAVORITE PASTA slogan mark at issue prior to when Barilla filed its intent-to-use application

AIPC provided no evidence of advertising expenditures and provided sales numbers for the wrong time period. AIPC admits that it "plac[ed] greater emphasis on product quality, package design and pricing rather than advertising and other promotions for its branded pastas, such as the Mueller's brand." *See* Opposer's Br., p. 14. Moreover, AIPC provides the amount of sales from the years 2000-2005. See Opposer's Br., p. 16; However, the key date by which AIPC must prove distinctiveness is June 18, 2002. Therefore, only the numbers between the years 2000 and 2002 are relevant to the instant question of acquired distinctiveness.

Even a successful advertising or sales campaign is not in itself necessarily enough to prove acquired distinctiveness with a highly descriptive mark such as AMERICA'S FAVORITE PASTA. *In re Boston Beer Co.*, 198 F.3d 1370, 53 U.S.P.Q. 2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark).

AIPC also claims that "by 2002" it had additional forms of advertising which help make the mark distinctive such as radio and print advertising campaigns featuring Rachel Ray. See Opposer's Br., p. 24; Lericos Dep., p. 43, ls. 23-25.

Moreover, the AMERICA'S FAVORITE PASTA slogan was closely marketed

with the house brand, MUELLER'S. *See* Lericos Dep., p. 90, ls. 20-25 and p. 91, ls. 1-7. As such, less significance must be assigned to the advertising expenditures by AIPC since it clearly promoted the MUELLER'S brand. *Philip Morris Inc. v. R.J. Reynolds Tobacco Co.*, 188 U.S.P.Q. at 293 id. ("And, in this case, the monies spent to promote the product, which prominently displayed the famous Marlboro trademark name, cannot be considered to have been used in 'a course of steady promotion of the mark Lights").

The evidence provided by AIPC with respect to this factor is not persuasive that the highly descriptive AMERICA'S FAVORITE PASTA slogan acquired distinctiveness prior to June 18, 2002 when Barilla filed its intent-to-use application.

C. The irrelevant survey evidence AIPC presents is unpersuasive

AIPC attempts to show consumer perception of the descriptive slogan AMERICA'S FAVORITE PASTA through the testimony of Drew Lericos, Vice President of Marketing and through four market research reports. However, the four market research reports are not relevant and/or helpful in this matter.

The first market research report entitled "Long Version" (AIPC Exhibit 75) only looks in the future and does not address how consumers perceive the slogan. *See* Lericos Dep., p. 61, ls. 20-25 and p. 62, ls. 1-4.

The second market research report entitled "Short Version" descriptively refers to the slogan AMERICA'S FAVORITE PASTA only once on page A05949 under Trust/Heritage, and does not show how consumer's recognize the slogan as an indication of origin. *See* Lericos Dep., Exh. 76, p. A05949.

The third market research report entitled "Mueller's Pasta Quantitative Research Results, Positioning Recommendation & Re-launch Action Plan of 2002" (Opposer's

Exh. 77) also only looks forward in time and does not show that consumer's recognize AMERICA'S FAVORITE PASTA as an indication of source for MUELLER's pasta.

The fourth, and final, market research report entitled "The March 2004 Consumer Research Study" occurred two years after Barilla filed its intent-to-use application, and is, therefore, irrelevant and should be given little weight. *See* Lericos Dep., Exh. 79. Moreover, the study compared eight AIPC brands (not including the slogan at issue): MUELLERS (north), MUELLER'S (south), GOLDEN GRAIN, MARTHA GOUCH, R&F, ANTHONY'S, RONCO, and LUXURY with each other and with "Barilla (the only national brand of pasta) and New World Pasta, and private label brands." *See* Opposer's Exh. 79, p. A011286. Mr. Lericos' testimony regarding this survey should also be given little weight. *See* Lericos Dep., p. 74, ls. 6-25 and p. 75 ls. 1, 18 – 22.

These market research reports and Mr. Lericos' testimony about them is not relevant or persuasive to the ultimate issue of whether or not consumers view AMERICA'S FAVORITE PASTA as a source indicator.

D. AIPC provided no affidavits asserting source-indicating recognition

In addition to not providing any affidavits to support its position that AIPC has acquired distinctiveness, Mr. Lericos, Vice President Marketing testified that no retailer or survey ever told him that a consumer asked for "AMERICA'S FAVORITE PASTA." *See* Lericos Dep., p. 103, ls. 16-19.

In summary, AIPC did not make trademark use of the slogan prior to June 2002 when Barilla filed its intent-to-use application. However, even if the Board finds that AIPC did make some trademark use prior to June 2002, this minimal proper trademark use in combination with the lack of substantial advertising expenditures and amount of

sales (during the relevant time period) and lack of relevant surveys and affidavits hardly meets the "compelling proof" required to find acquired distinctiveness for the "merely laudatory" AMERICA'S FAVORITE PASTA slogan.

II. AIPC'S FLAG DESIGN MARK DID NOT ACQUIRE DISTINCTIVENESS PRIOR TO BARILLA'S FILING OF ITS INTENT-TO-USE APPLICATION AND THEREFORE, CANNOT BE A BASIS FOR THIS OPPOSITION

AIPC cites two applications/marks in support of the instant opposition proceeding. *See* Opposer's Notice of Opposition, p. 2. The first application/mark – AMERICA'S FAVORITE PASTA (Serial No. 76/497,489) was discussed above. AIPC filed the second application on March 14, 2003 for the component mark AMERICA'S FAVORITE PASTA and flag design Serial No. 76/497,190 for "pasta" claiming a date of first use of May 2002. *See* Lericos Dep., Ex. 86. On June 18, 2002, Barilla filed its intent-to-use application for BARILLA AMERICA'S FAVORITE PASTA. *See* Pereira Dep., Ex. 2.

Based on the arguments set forth in the preceding section, AIPC has not established acquired distinctiveness of this combined word and design mark prior to June 18, 2002 when Barilla filed its application. This application cannot be a basis of the subject opposition because it lacked distinctiveness when Barilla filed its intent-to-use application. *See* Lericos Dep., p. 95, ls. 17-20 and p. 96, ls. 18-21.

III. IF THE BOARD FINDS THAT AIPC HAS ACQUIRED DISTINCTIVENESS PRIOR TO BARILLA FILING ITS INTENT-TO-USE APPLICATION, THERE CAN BE NO LIKELIHOOD OF CONFUSION BETWEEN THE MARKS AT ISSUE

AMERICA'S FAVORITE PASTA is a weak mark and Barilla is in fact the leading seller of pasta in America, so consumers cannot and will not be confused as to the source of the pasta. *See* Pereira Dep., p. 11, ls. 10-21.

AIPC mistakenly claims that Barilla's expert, Kenneth Germain, conceded that there would be likelihood of confusion between the marks at issue:

> The parties' respective marks are confusingly similar under the applicable factors as considered by the Board. As Barilla's proffered expert puts it: The phrases are very similar. The phrases are identical. The only difference between the two parties' marks is that the applicant's mark has Barilla on the front end. America's Favorite Pasta is the same. And they are both pasta. So we have largely the same mark, same goods, and you're first. So what is to argue?

See Opposer's Br., pp. 26-27 citing Germain Dep., p.85, l. 13 through p. 86, l. 11. However, Germain's deposition actually states:

> *Q.* *So how did you know or select what to opine about then?*
>
> *A.* *I think it was pretty obvious that the issue here is whether, I mean your client apparently had first use. The phrases are very similar. The phrases are identical. The only difference between the two parties marks is that the applicant's mark has Barilla at the front end. America's Favorite Pasta is the same. And they are both Pasta. So we have largely the same mark, same goods, and you're first. So what is to argue? Well, what is to argue is, does your client have a mark, does it have something that is distinctive which under the Auto {Ottto} Roth CCPA 1981 case gives position to object? So that looked like the issue.*

See Germain Dep., p. 85, l. 3 through p. 86, l. 6.

This was not an admission that there would be a likelihood of confusion if Barilla's mark matured into a registration but simply framing the issue at hand – whether or not AIPC has trademark rights to the AMERICA'S FAVORITE PASTA slogan.

Resolution of the likelihood of confusion issue before the Board is governed by the thirteen factors set forth in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Significantly, in asserting likelihood of confusion under the Lanham Act, no one factor is determinative and each case must be decided on its own facts. *Id.* The DuPont factors are as follows:

> (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
> (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
> (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
> (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
> (5) The fame of the prior mark (sales, advertising, length of use).
> (6) The number and nature of similar marks in use on similar goods.
> (7) The nature and extent of any actual confusion.
> (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
> (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
> (10) The market interface between applicant and the owner of a prior mark.
> (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
> (12) The extent of potential confusion, i.e., whether de minimis or substantial.
> (13) Any other established fact probative of the effect of use.

Du Pont, 476 F.2d 1361.

AIPC's slogan, even if deemed to have acquired distinctiveness prior to June 18, 2002 when Barilla filed its intent-to-use application, is still such a weak indicator of source, that the differences in marks – the addition of the well-known BARILLA mark – makes confusion highly unlikely. Weak marks are not afforded the same scope of protection as stronger marks. *Drackett Co. v. H. Kohnstamm*, 160 U.S.P.Q. 407 (C.C.P.A. 1969). Therefore, the lack of fame of AIPC's alleged slogan in combination with the differences in the marks at issue makes confusion remote. Barilla is the leading

seller of pasta in the United States, so AMERICA'S FAVORITE PASTA accurately describes Barilla's stature as the U.S. consumer's favorite brand of pasta.[3] See Pereira Dep., p. 11, ls. 10-21.

AIPC attempts to paint Barilla as a bad faith adopter of the BARILLA – AMERICA'S FAVORITE PASTA mark by alleging that Barilla did not have a bona fide intent to use the mark. *See* Opposer's Br., p. 34. This is unsupported by the record. Barilla is the only brand of pasta sold nationwide, and the leading seller of pasta in the United States. See Pereira Dep., p. 11, ls. 10-21. It filed an application for BARILLA – AMERICA'S FAVORITE PASTA to inform consumers of these facts. See Pereira Dep, p. 10, ls. 7-16.

Moroever, contrary to AIPC's argument that third-parties are not using similar marks for use on similar goods, the record proves otherwise. *See* Opposer's Br., p. 35. AIPC itself uses AMERICA'S FAVORITE NOODLE as advertising for its noodles. *See* Webster Dep., p. 35, ls. 19-21. AIPC's exhibits 0115 through 0214 show many registrations of AMERICA'S FAVORITE on foods, pizza, pizza crust, etc. These registrations all contain the non-generic portion of the mark – AMERICA'S FAVORITE. Barilla's NameProtect report (Exhibit 30) addresses the current use of AMERICA'S FAVORITE in the food and related classes from the ninety-seven registration certificates

[3] AIPC only promotes its MUELLER'S brand in the eastern half of the United States, which it calls "Muellerland." *See* Webster Dep., p. 54, l. 4. Moreover, it began using the slogan AMERICA'S FAVORITE PASTA to convey to the consumer that Mueller's pasta products were "American-made pasta for the way Americans enjoy pasta. So it's very much an Americana positioning." *See* Lericos Dep., p. 60, ls. 11-18.

provided by AIPC solely to show that use of registered marks comes and goes and that AMERICA'S FAVORITE is a common term of puffery in the food industry.

As for use of the slogan AMERICA'S FAVORITE PASTA, there are third-party uses – a spaghetti cook book by Joie Warner with the descriptive slogan AMERICA'S FAVORITE PASTA on the cover. See Lericos Dep., p. 104, ls. 3-4.

AIPC has not met its burden of proof with respect to any likelihood of confusion between the marks at issue.

IV. AIPC FAILED TO MEET ITS BURDEN OF PROOF IN DEMONSTRATING THAT BARILLA DID NOT HAVE A BONA FIDE INTENT-TO-USE THE BARILLA-AMERICA'S FAVORITE PASTA MARK WHEN IT FILED ITS APPLICATION

AIPC failed to meet its burden of proof that Barilla did not have a bona fide intent-to-use the mark BARILLA – AMERICA'S FAVORITE PASTA.

AIPC must establish, by a preponderance of the evidence or persuasive argument, its claim of a lack by Barilla of the requisite *bona fide* intention to use its mark on or in connection with pasta in the BARILLA – AMERICA'S FAVORITE PASTA application. American Heritage Life Insurance, Heritage Life Insurance Co., id. Here, AIPC has offered absolutely no evidence to prove either wrongful intent by Barilla in filing the application nor has it presented a persuasive argument with respect thereto. AIPC has therefore failed to establish a prima facie case that Barilla's application is invalid for lack of the requisite *bona fide* intention to use its mark, which would shift the burden to Barilla of coming forward with evidence to refute such case. *See, e.g., Yamaha International Corp.*, 840 F.2d 1572.

Section 1(b) of the Lanham Act "requires that an applicant, in an intent to use application, make a verified statement . . . that it has a 'bona fide intention' to use the

mark in commerce," and Congress purposely omitted a statutory definition of the term "bona fide" as used in the phrase "bona fide intention," in the interest of preserving "the flexibility which is vital to the proper operation of the trademark registration system." 15 U.S.C. § 1051; S. Rep. at 24.

AIPC points to two alleged reasons why Barilla had no bona fide intent-to-use the mark at issue. Both reasons fail to shift the burden to Barilla to come forward with evidence to refute such a case.

First, AIPC points to the fact that Barilla filed four intent-to-use trademark applications on the same day for what it considers to be "nearly identical marks," for the "same products," namely BARILLA – AMERICA'S FAVORITE PASTA; BARILLA – AMERICA'S PREFERRED PASTA; BARILLA – AMERICA'S #1 PASTA; and BARILLA – AMERICA'S BEST PASTA.[4] *See* Opposer's Br., p. 38. It is worthy to note that these marks all have a similar connotation, but are hardly "nearly identical." While it is indeed the case that the filing of four intent-to-use applications *may* be sufficient to cast doubt on the bona fide nature of Barilla's intent, AIPC has provided no evidence of the same. Contrary to AIPC's assertion, multiple intent-to-use applications for the same goods is not tantamount to a lack of a bona fide intention on Barilla's part. The Lanham Act's legislative history makes clear that an applicant's bona fide intention to use a mark can be definite, yet contingent on the happening of an outside event. Therefore, applications for more than one mark for the same goods can be filed at the same time. The Senate Judiciary Committee stated "An Applicant's bona fide intention

[4] Barilla permitted the intent-to-use application for BARILLA – AMERICA'S BEST PASTA to lapse. See Pereira Dep., p. 22, ls. 4-5.

to use a mark must reflect an intention that is firm, thought it may be contingent on the outcome of an event (that is market research or product testing.)" *Senate Judiciary Committee Report* on S. 1883, S. Rep. No. 100 – 515, pp. 24-25 (Sept. 15, 1988). Similarly, the House Judiciary Committee also clarified "[T]he Committee recognizes that this system may allow a person, under certain circumstances, to apply to register more than one mark. For example, an applicant in good faith may apply to register more than one mark because he or she is unable to determine without test-marketing which mark will be the most commercially viable." *House Judiciary Committee Report* on H.R. No. 100 – 1028, p. 9 (Oct. 3, 1988); *See also* 3. J. Thomas McCarthy § 19:15, 2005 ed. Moreover, unlike the cases cited by AIPC wherein one product is at issue, these slogans filed for by Barilla could all be used. There is no reason for Barilla to select just one because they are all accurate.

Second, AIPC points to Barilla's testimony that it filed its application to "notify consumers that contrary to Mueller's false claim, Barilla was the leading brand of pasta in terms of market share in the United States." *See* Opposer's Br., p. 37. How does one "notify consumers" if it does not use the mark? Barilla had and continues to have the intent to use the mark at issue to "notify consumers that . . . Barilla was the leading brand of pasta in terms of market share in the United States." *See* Opposer's Notice of Reliance, Ex. 219. Moreover, Mr. Pereira, Vice President of Marketing, testified that filing of four similar intent-to-use applications came about when BARILLA became the number one brand in sales in the United States. See Pereira Dep., p. 9, ls. 3-6, p. 13, ls. 1-24, p. 14, ls. 1-4.

These two instances clearly do not shift the burden of proof to Barilla, and therefore, Barilla's application is entitled to register as Barilla had a bona fide intent-to-use the mark BARILLA – AMERICA'S FAVORITE PASTA.

V. EVIDENTIARY MATTERS

A. Kenneth Germain's testimony and report should not be stricken

Barilla has obtained the expert report and testimony of Kenneth Germain, a highly accomplished attorney and law professor, concerning whether or not AIPC's use of its AMERICA'S FAVORITE PASTA mark is sufficient to establish acquired distinctiveness. In his report and testimony, Mr. Germain criticizes the declaration and deposition of one of AIPC's witnesses, Ms. Ann Willoughby, in which she theorizes that AIPC's use of its mark up to this point has created acquired distinctiveness in the mark. As any effective rebuttal expert report does, Mr. Germain logically disproves AIPC's theories based on his knowledge and expertise. Predictably, AIPC now objects to Mr. Germain's report and testimony as being incompetent, lacking in foundation and speculative. Barilla disagrees.

AIPC cites *Goodyear Tire* in support of its arguments. (Opposer's Br. 41). However, *Goodyear Tire* addresses whether an expert was qualified to testify as to the descriptiveness of a mark and the Board found that the purported expert was not an expert in the relevant field. *Goodyear Tire & Rubber Co. v. Con't. General Tire, Inc.*, 70 U.S.P.Q. 2d 1067, 1069 (T.T.A.B. June 11, 2003). However, in this case, the Board has already determined that AMERICA'S FAVORITE PASTA is descriptive. SJ Decision p. 5. Mr. Germain was not testifying on this issue. Mr. Germain was testifying

on whether or not the mark had acquired distinctiveness. See Germain Dep., p. 12, ls. 21-24. On this issue, he is more than qualified.

Specifically, Mr. Germain reviewed the following to form his opinions:

1. Complaint for Declaratory Judgment in *American Italian Pasta Co. v. New World Pasta Co.*, 4:02-cv-00594-SOW (W.D. Mo.) (6/18/02)
2. Notice of Opposition (7.22.04); Answer to Notice of Opposition (9/28/04) Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding (3/3/05)
3. Opposer's Notices of Reliance Under Rule 2.122(c) (with exhibits)
   a. Re Opposer's Exhibits 115-218
   b. Re Opposer's Exhibits 219-23
   c. Re Opposer's Exhibits 224-25
   d. Re Opposer's Exhibits 226-27
4. Declarations:
   a. T.S. Webster (3/3/06), including his Declaration in the New World case (11/13/02)
   b. A Willoughby (3/6/06), including her Report, with exhibits, in the New World case (2/21/03)
   c. D. Lericos (3/3/06), with some exhibits
5. Depositions:
   a. T.S. Webster (11/9/06), with exhibits and related procedural documents
   b. A. Willoughby (11/3/06)
   c. A.J. Lericos (11/3/06)
6. Reports:
   a. AIPC Brand health Tracking Study (Wave I), produced by Synovate (3/04)
   b. Name Protect Trademark Investigation Report (11/28/06)
7. U.S. PTO Records:
   a. File History on U.S. Trademark Appl. Ser. No. 78/136,703
   b. Miscellaneous files obtained from www.uspto.gov
8. Miscellaneous photocopied photographs of Opposer's MUELLER's pasta packages
9. Printouts from www.aipc.com (12/12/06)
11. Schedule 2.1(a) [starting with page. 5, and tab B] to "Asset Purchase Agreement."
10. Joi Warner's book, "Spaghetti...america's favorite pasta" (1st ed. 1994), with dust jacket

As for laying a proper foundation, Mr. Germain's qualifications to provide an expert opinion with respect to the facts surrounding acquiring distinctiveness are without

question. As established in his expert report, Mr. Germain has practiced in trademark law for over thirty years, has taught trademark law for nearly twenty years, has written twenty-four publications concerning various trademark law topics, and has given nearly two hundred different lectures on trademark law. *See* Germain Report, Exh. 1. Therefore, Mr. Germain's background and experience lays an adequate foundation and properly qualifies him as an expert who can testify as to the type and level of use that is required to establish acquired distinctiveness in a mark.

Furthermore, Mr. Germain's expert conclusions are not speculative, but rather are based upon his specialized knowledge and grounded in sound reasoning and principles. His testimony is not about pure principles of trademark law, as AIPC contends. Rather, his testimony merely contradicts the opinion put forth by Ms. Willoughby concerning the facts of this case and contends that AIPC's use, in fact, does not adequately demonstrate acquired distinctiveness.

For the foregoing reasons, Mr. Germain's expert report and testimony should not be stricken.

B. Joslyn Poquette's testimony should not be stricken because it is relevant and does not lack foundation and is admissible evidence

In this proceeding, AIPC introduced ninety-seven trademark registrations for various "AMERICA'S FAVORITE" marks into the record as an attempt to demonstrate that such marks are capable of acquiring distinctiveness necessary for registration. To demonstrate the typical use of these marks within the food and restaurant industry, a reputable trademark search firm, NameProtect, Inc., conducted a routine investigation into the use of these registrations. To authenticate the report, Barilla deposed Joslyn Poquette, a Client Services Account Manager at NameProtect, Inc. and creator of the

Report. AIPC erroneously asserts that Ms. Poquette's testimony should be stricken because the Report is not relevant and her testimony lacks foundation and is inadmissible hearsay. (Opposer's Br. 44-47).

The NameProtect Report is relevant to this proceeding as it directly relates to registrations that AIPC itself introduced into evidence. The Board needs context with respect to AIPC's evidence supporting its contentions. AIPC cannot now assert that other evidence that may call into question the strength of these registrations is not relevant. More specifically, the NameProtect Report is merely a standard report created by trademark search firms that demonstrates how third-party registrations are, in fact, used by their respective owners. Throughout the NameProtect Report, evidence shows that may prove that "AMERICA'S FAVORITE" marks in the food and restaurant industry are perceived as a weak designation of source by consumers and businesses alike. Such evidence is clearly relevant.

AIPC's lack of foundation objection under F.R.E. 602 is also misplaced. AIPC's objection is based on its assertions that the nature of the NameProtect Report was incomplete and that Ms. Poquette lacked knowledge about the marks investigated. This is not an appropriate objection. Ms. Poquette's testimony merely serves to authenticate the NameProtect Report and introduce it into evidence. She is not an expert witness and, therefore, is not testifying with respect to meaning of the Report with respect to this proceeding. Therefore, foundation for such purposes may be established by demonstrating that Ms. Poquette has personal knowledge of the creation of the report. Ms. Poquette furnishes the foundation requirements in her testimony. Specifically, she explicitly states that she created the NameProtect Report in the normal course of

business, that the NameProtect Report is "the kind of report that NameProtect normally sells" and that she created it in the same manner as she would for any other request for such a report. *See* Poquette Dep., at pp. 10, 34. Moreover, Ms. Poquette explicitly described how she created the NameProtect Report. *Id.* at pp. 10-12. Therefore, the record clearly demonstrates that Ms. Poquette possesses personal knowledge of the NameProtect Report for purposes of authenticating it.

For these same reasons, AIPC's objection that the report and Ms. Poquette's testimony constitutes inadmissible hearsay must also fail. AIPC bases its inadmissible hearsay objection on its claims that Ms. Poquette "is in no position to personally authenticate the websites viewed on the internet" and that Barilla was required to provide testimony from all of the individual website owners in order to submit the NameProtect Report into evidence. (Opposition Br. 46). This is contrary to the law. Ms. Poquette is authenticating the search she performed and the resulting NameProtect Report, not the individual websites that resulted from the search, and the Board allows submission of such third-party reports to be considered part of the record. *See Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 U.S.P.Q. 341, 355-356 (T.T.A.B. 1978) (Dun & Bradstreet report is admissible for what they show on their face and is considered part of the record). In *Stagecoach Properties*, the Board allowed a Dun & Bradstreet report into evidence because Dun & Bradstreet is the type of business that depends upon its accuracy and reliability and the Dun & Bradstreet report offered evidence that otherwise might only be obtained through unreasonable means. *Id.* This is precisely the situation at hand. The NameProtect Report was created by a trademark search firm that depends upon the accuracy and reliability of its reports and offers into evidence information that otherwise

may only be obtained through unreasonable means (*i.e.*, authenticating each internet page through testimony of individual internet page owners) (as AIPC suggests in its brief).

For the foregoing reasons, the NameProtect Report and Ms. Poquette's testimony are relevant and admissible.

C. Willoughby's testimony and report should be accorded limited weight

AIPC provided the testimony and report of Ms. Ann Willoughby. This testimony should be given limited weight in determining (1) whether AIPC's AMERICA'S FAVORITE PASTA slogan serves a trademark function and/or impacts consumers as to brand recognition because it lacks foundation and addresses ultimate questions of law to be answered by the Board; and (2) the history of the AMERICA'S FAVORITE PASTA slogan. (Willoughby Report p. 6).

Ms. Willoughby's report and testimony lacks foundation. As Mr. Germain accurately concluded, "[a]lthough Ms. Willoughby is quite experienced in the design aspects of product packaging and advertising, including what she calls 'branding,' she lacks a firm understanding of trademark law principles relevant to 'branding.' For one thing, she was much less buyer/user-centered than appropriate in her appraisal of the effect of the "America's Favorite Pasta" phrase AIPC claims as its trademark. Ms. Willoughby never questions whether "America's Favorite Pasta" (without any express indicator of claimed trademark status – such as a superscript 'TM'), the phrase used by AIPC in its packaging, advertising and promotions, made a commercial impression sufficiently separate and distinct from AIPC's overall 'trade dress' so as to amount to 'use as a trademark' and, potentially, to qualify for acquired distinctiveness status." *See* Germain Report, p. 5. Moreover, whether or not AIPC's AMERICA'S FAVORITE

PASTA slogan serves a trademark function and/or impacts consumers as to brand recognition are precisely the questions of law to be answered by the Board.

Ms. Willoughby's report and testimony also purports to provide a history of the AMERICA'S FAVORITE PASTA slogan. (Willoughby Report p. 6). However, the evidence relied upon by Ms. Willoughby is not properly before the Board. It has not been authenticated by AIPC. In her report are the following examples:

"At the same time in the early days of packaged goods development, when Mueller's was a new brand, it was common to adopt patriotic imagery and names that associated the product with ideas that consumers respected." Willoughby Report ¶ 17.

- The Mueller's brand has evolved over a long period and the trade dress elements of the brand identify that are part of the trademark were first used starting in the early 1900's and thus have equity with consumers. The first use of the phrase "America's Favorite" on the Mueller's packaging was in the mid-fifties.
- Mueller's brand identity (image) and trade dress was established over the past 100 years.
- Note in Exhibit B, Mueller's packaging from 1914 (the first sample found).

For the above-stated reasons, the report and testimony put forth by Ms. Willoughby should be accorded limited weight.

Dated: May 29, 2007

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the following **APPLICANT'S TRIAL BRIEF** was served this 29th day of May 2007, by First Class Mail, postage prepaid, on the following counsels for AIPC:

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